

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

Group I: Claims 1-14, 18-19, 42-57 and 61-63, drawn to compounds of the general formula (I) seen in claim 1 and simple compositions thereof.

Group II: Claims 15-17 and 58-60, drawn to methods of preparing said compounds in group I.

Additionally, an election of a single disclosed chemical specie of formula (I) has been required.

Applicants elect, with traverse, Group I, Claims 1-14, 18-19, 42-57 and 61-63 (drawn to compounds of the general formula (I) and compositions thereof), for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: "The prior art by Bock et al. (US Patent 5,665,719), which is mentioned in the ISR, teaches a compound that reads on claim 1 (see col. 30, example 10). Therefore, the compounds and methods are not novel and the invention lacks a special technical feature."

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims *interpreted in light of the description* was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product;. . .”

In addition, The MPEP §806.03 states:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I and II with respect to 37 C.F.R. § 1.475(b)(1) and MPEP §806.03. Therefore the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met.

Additionally, Applicants provisionally elect, without traverse, the following species of general formula (I) for examination purposes only (at least claims 1-13, 18, 19, 42-56 and 61-63 readable thereon): 1-[1-(1-naphthalene-1-sulfonyl)-piperidin-4-yl]1,4-dihydro-benzo[d][1,3]oxazine-2-one. This specie equates to R<sup>1</sup>-R<sup>9</sup> being hydrogen and W being an aryl radical (namely 1-naphthyl) of formula (I).

Application No. 10/566,404

Reply to Restriction Requirement of December 1, 2008

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.


Respectfully submitted,

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